



UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mark Levy
HINMAN, HOWARD & KATTELL, LLP
80 Exchange Street
P.O. Box 5250
Binghamton, NY 13901

MAILED

JUN 20 2011

OFFICE OF PETITIONS

In re Patent No. 5,927,278
Issued: July 27, 1999
Application No.: 09/135,189
Filing Date: August 18, 1998
Attorney Docket No.

: REQUEST FOR INFORMATION
:
:
:
:

This is a request for information in response to the petition under 37 CFR 1.378(b), filed October 12, 2010, to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed September 28, 2009. No additional fees are due.

The patent issued July 27, 1999. The 7.5 year maintenance fee could have been paid from July 27, 2006, through January 27, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from January 28, 2007, to July 27, 2007. Petitioner did not do so. Accordingly, the patent expired at midnight on July 27, 2007.

By the instant petition, petitioner asserts that:

- patentee's former counsel, the late Terrance Siemens forwarded patentee correspondence on, October 14, 2006, indicating that Mr. Siemens law firm was closing. The letter advised patentee that all of maintenance fee information for the patent was being sent to Mark Levy of Mark Levy and Associates so that Mr. Levy could assist with the tracking and payment of the maintenance fees, if patentee wished.
- The letter of October 14, 2006, also advised that a Change of Correspondence Address form was enclosed which patentee should complete and sign and return to Mr. Levy so that it could be forwarded to the USPTO.
- Mr. Levy never received an authorization to represent patentee in the matter. Neither did Mr. Levy receive a copy of the October 14, 2006 letter.

It is noted that the period for paying the 7.5-year maintenance fee began July 27, 2006, and ended July 26, 2007. Within that period—specifically October 2006—patentee was sent correspondence from Mr. Siemens law firm indicating that the Office was closing. Implicit in this letter is the fact that Mr. Siemens

law firm would no longer be responsible for tracking and paying the maintenance fee for the subject patent. Further, the letter gives clear instruction that if the patentee desires the professional services of other counsel to track and pay the maintenance fee, patentee should complete the enclosed forms and contact Mr. Mark Levy. By the instant petition, Mr. Levy states that the patentee did not contact Mr. Levy until August 31, 2010. The instant petition demonstrates that, in fact, the focus of the 1.378(b) petition, and whose delay was unavoidable, is largely that of the patentee because Siemens law firm severed its representation of the patentee in October of 2006, and no other counsel was sought until August 2010.

Based on the aforementioned, petitioner is required to address the following points:

- Did patentee receive the letter dated October 14, 2006, from Siemens law firm?
- If so, what action, if any, did patentee take in response to the letter?
- Petitioner must also address how patentee treated the maintenance of the patent as patentee's most important business. Petitioner must demonstrate that the patentee acted reasonably and diligently relative to the maintenance of the patent. Specifically, petitioner may wish to address how patentee tracked the maintenance fee payment schedule for the patent, if at all.
- Petitioner is required to explain whether Mr. Levy, or any associated law firm, received funds from patentee in order to pay the 7.5-year maintenance fee. If so, petitioner should explain what happen to those monies.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

By facsimile: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition Attorney
Office of Petitions